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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
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08/450,641 05/25/95 KOLEN

P 07367/002001

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33M1/0710

EXAMINER
ROBINSON, R

ART UNIT PAPER NUMBER

3311

DATE MAILED:

12

07/10/96

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

- ☐ Responsive to communication(s) filed on 4/19/96
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 8-18 is/are pending in the application.
- Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 8-18 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claims _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☒ Notice of Reference Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

-- SEE OFFICE ACTION ON THE FOLLOWING PAGES --

DETAILED ACTION

The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to provide an enabling disclosure. The disclosure fails to teach one skilled in the art, the operation of the pump/heat exchanger and how it cooperates in combination with the other elements. Neither the written description or the drawings gives sufficient information on the operation of the pump/heat exchanger.

Claims 8-18 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

2. Claims 8-11 and 13 are rejected under 35 U.S.C. § 102(e) as being clearly anticipated by Koewler.

3. Claims 8-18 are rejected under 35 U.S.C. § 102(b) as being anticipated by French et al. French et al discloses a system for circulating hot or cold liquid through a pad placed in thermal contact with a patient for thermal therapy. The system includes a flexible thermal pad with an internal channel for carrying the liquid and a pump assembly for circulating and optionally heating the liquid. Column 9, line 26-column 12, line 68, discloses the controller with inherently the same functions as the control mechanism claimed. Included in the control mechanism are three separate over-temperature sensors.

4. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

5. Claims 12 and 14-18 are rejected under 35 U.S.C. § 103 as being unpatentable over Koewler in view of French et al. Koewler discloses the basic device as claimed, however Koewler does not disclose the control mechanism that features an alarm. French et al discloses a control mechanism that has the same functions as the control mechanism claimed. It would have been obvious to one skilled in the art to use the therapy device of Koewler and modify it by adding the control mechanism as taught in French et al in order to enhance the operation of the device.

The examiner finds the arguments dealing with the 112 rejections concerning the alarm persuasive, the arguments concerning the pump/heat exchanger non-persuasive. The applicant's remarks don't agree with the disclosure. Page 5 of the remarks, lines 4-

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6 states valve 14 receives water from tube 17 and recirculated water from separator 15. The specification states tube 17 is a vent tube(p.14, last paragraph) and the disclosure is silent as to how separator 15 connects to valve 14. The specification at page 11, lines 17-19, states separator 15 returns water to reservoir. Due to this, the 112 rejection regarding the pump/heat exchanger stands.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Herman J. Robinson whose telephone number is (703) 308-2909.


LEE S. COHEN
PRIMARY EXAMINER
GROUP 3300

H.J.R.
June 28, 1996